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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,974	10/14/2003	Darlene Coleman Deccher	AM101222 US(WYNC-0714)	7110
38791 7590 08/16/2007 WOODCOCK WASHBURN LLP/WYETH CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			EXAMINER CARTER, KENDRA D	
			ART UNIT 1617	PAPER NUMBER
			MAIL DATE 08/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/685,974	Applicant(s) DEECHER ET AL.	
	Examiner Kendra D. Carter	Art Unit 1617	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 August 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1, 4-6 and 13-22.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER

Continuation of 5. Applicant's reply has overcome the following rejection(s): In light of the amendment to claim 1, the 35 USC 112, first paragraph rejection of claims 1, 4-6 and 13-22 is withdrawn. Additionally, in light of the amendment to claims 13 and 14, the claim objection is withdrawn.

Continuation of 11. does NOT place the application in condition for allowance because: The amendments to claims 1, 13 and 14 have been entered, but do not place the application in condition for allowance because of the reasons below.

The 35 USC (103(a) rejection of claims 1 and 13-18 as being unpatentable over Berendsen of record is upheld.

The 35 USC (103(a) rejection of claim 5 as being unpatentable over Berendsen as applied to claims 1 and 13-18 above and further in view of Carr et al. of record is upheld.

The 35 USC (103(a) rejection of claims 4, 21 and 22 as being unpatentable over Berendsen as applied to claims 1 and 13-18 above and further in view of Stearns et al., and further in view of Janowsky et al. of record is upheld.

The 35 USC (103(a) rejection of claim 6 as being unpatentable over Berendsen as applied to claims 1 and 13-18 and further in view of Stearns et al., and further in view of Janowsky et al. as applied to claim 4 above, and further in view of Carr et al. of record is upheld.

The Applicant's arguments have been fully considered but are not persuasive.

The Applicant argues that there is not motivation to modify the Berendsen reference to achieve applicant's claimed invention, as urged by the Office. The Examiner disagrees because a specific teaching, suggestion or motivation is not required to support a finding of obviousness. See the recent Board decision *Ex parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing KSR, 82 USPQ2d at 1396) (available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071925.pdf>).

The Applicant argues that venlafaxine is an NRI/SRI not an NRI, as required by claim 1, as amended. Thus, an NRI and a 5HT2a receptor antagonist is not taught. The Examiner disagrees because the claim does not limit venlafaxine to be a selective NRI, thus venlafaxine is still an NRI. The combination arguments are addressed below.

The Applicant argues that a skilled artisan would have conflicting information with respect to the usefulness of a 5HT2a receptor antagonist in treating hot flush and therefore would not have a reasonable basis for concluding that the claimed invention would have been obvious to do. The Examiner disagrees because the examples cited by the Applicant are in the specification and not from the Berendsen reference. The Berendsen reference teaches that at the time of the invention 5HT2a receptor antagonist are a viable way to treat hot flashes (see 159, column 2 in its entirety and the flow chart).

The Applicant argues that the Office has not established that there would be a reasonable expectation of success of using a combination of an NRI and a 5HT2a receptor antagonist to treat hot flush. The Office cannot use hindsight reconstruction or pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. A proper prima facie obviousness rejection was not established. The Examiner disagrees because the reasons for expectation of success are given on page 11 of the final action, paragraph 3 in its entirety. Furthermore, a case of prima facie obviousness was established in the final rejection as set forth by *Graham v John Deere*. The idea of combining the teachings of Berendsen flows logically from their having been individually taught in the prior art. See *In re Kerkhoven*, 626 F.2d 846,850, 205 USPQ 1069, 1072 (CCPA 1980). The combination is implicitly showed by the combined teachings knowledge of one of ordinary skill in the art and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.

The Applicant argues that claims 4-6 and 19-22 are not rendered obvious with the other references because of the arguments above. The Examiner disagrees for the reasons stated above.